

## REMARKS

### **Status of the claims**

Claims 1-11 are pending in this application, with claim 1 being in independent form.

Claims 1-11 have been amended to define still more clearly what Applicant regards as his invention; these changes have been made for the purposes of clarification only, and no change in scope of the claims is either intended or believed to be effected by the changes.

### **The rejection under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph**

Claim 1 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Specifically, the Examiner states that the recitation "the superficial crack line" in line 2 of claim 1 lacks antecedent basis in the claim.

The claims have been carefully reviewed and amended as deemed necessary to ensure that they conform fully to the requirements of Section 112, second paragraph, with special attention to the points raised in the Office Action. Applicant also has the specific remarks presented on the following page:

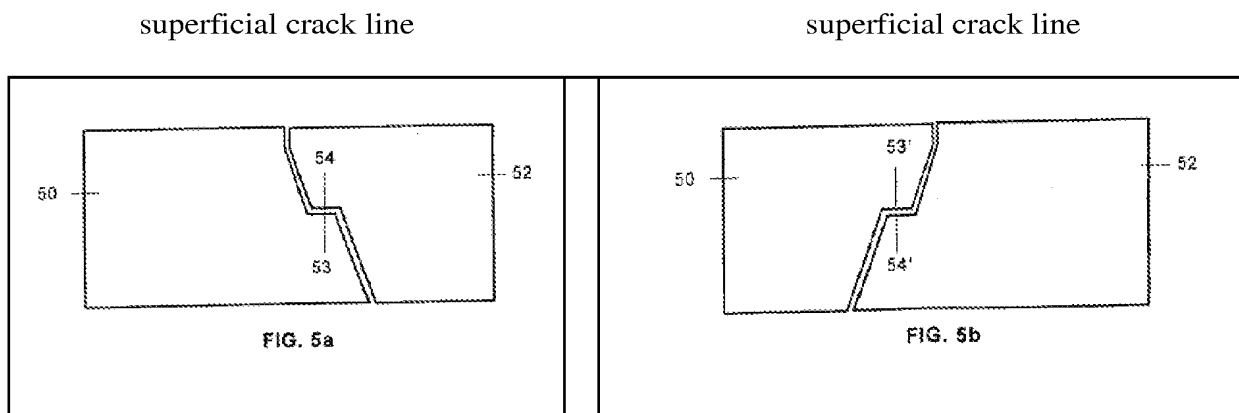
*Recitation "the superficial crack line" in claim 1*

Antecedent basis for the recitation “the superficial crack line” in claim 1 can be found in, at least, the following paragraphs of the description. (The numbered paragraphs below are from the version of the published application, US 2006/0277856.)

[0008] Therefore the object of the present invention is a device for forming contraction joints in concrete works constituted of a plurality of trays of a concrete divider material assembled on stiff linear members in an alternating manner on either side of the superficial crack line on the upper side of the concrete surface, and leaving gaps between them to allow for the cracking.

[0012] This waterproofing joint furthermore serves to indicate the site where the cracking of the concrete is to occur, which will be alternately “directed” on either side of said joint in different areas defined by said trays in order to leave the edges of the members resulting from the cracking alternately supported with one another. The cracking automatically occurs due to shrinkage or due to load.

[0020] FIGS. 5a and 5b show elevational views of the ends of two adjacent slabs in the joint formed using the device illustrated in FIGS. 2 and 3 in areas occupied by trays arranged on different sides of the superficial crack line.



[0023] Said trays 3, 3', which will usually be prefabricated, are alternately arranged on either side of the superficial line provided for the crack of the concrete, situated on the same vertical plane as the stiff linear member 11, usually leaving gaps 16 between them, although it may be useful to position the trays 3, 3' one against the other for certain applications.

[0043] The device for forming contraction joints according to the present invention includes gaps 16 between alternating trays 3, 3'; 12, 12' so that the crack of the concrete resulting from shrinkage or from the action of a load can easily vary its orientation to either side of the superficial crack line by following the surfaces of said trays 3, 3'; 12, 12'.

It is of course to be understood that the references to various portions of the present application are by way of illustration and example only, and that the claims are not limited by the details shown in the portions referred to.

For at least the foregoing reasons it is believed that the rejection under Section 112, second paragraph, has been obviated, and its withdrawal is therefore respectfully requested.

### **The rejections under 35 U.S.C. § 102/103**

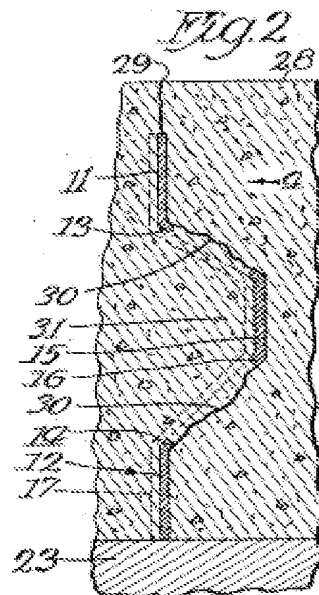
- Claim 1 was rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 1,978,278 to *O'Brien*.

- Claims 2-11 were rejected under 35 U.S.C. § 103(a) as being obvious from *O'Brien*.

Applicant submits that independent claim 1, together with the claims dependent therefrom, are patentably distinct from the cited references for at least the following reasons.

Claim 1 is directed to a device (1) for forming contraction joints in concrete works including a plurality of alternating members on either side of a superficial crack line situated on the upper side of the concrete surface. The members are constituted of trays (3, 3'; 12, 12') of a concrete divider material, and the device (1) comprises a plurality of trays (3, 3'; 12, 12') assembled on stiff linear members (7, 9, 11), leaving gaps (16) between them.

*O'Brien*, as understood by Applicant, relates to a joint for concrete slabs. *O'Brien* refers, as can be clearly seen in Figure 2 of that patent (see below) to "a crack-locating" device (using a term of *O'Brien*) towards only one side of line 29 (the same line as the above-mentioned "superficial crack line"). See the drawing below:

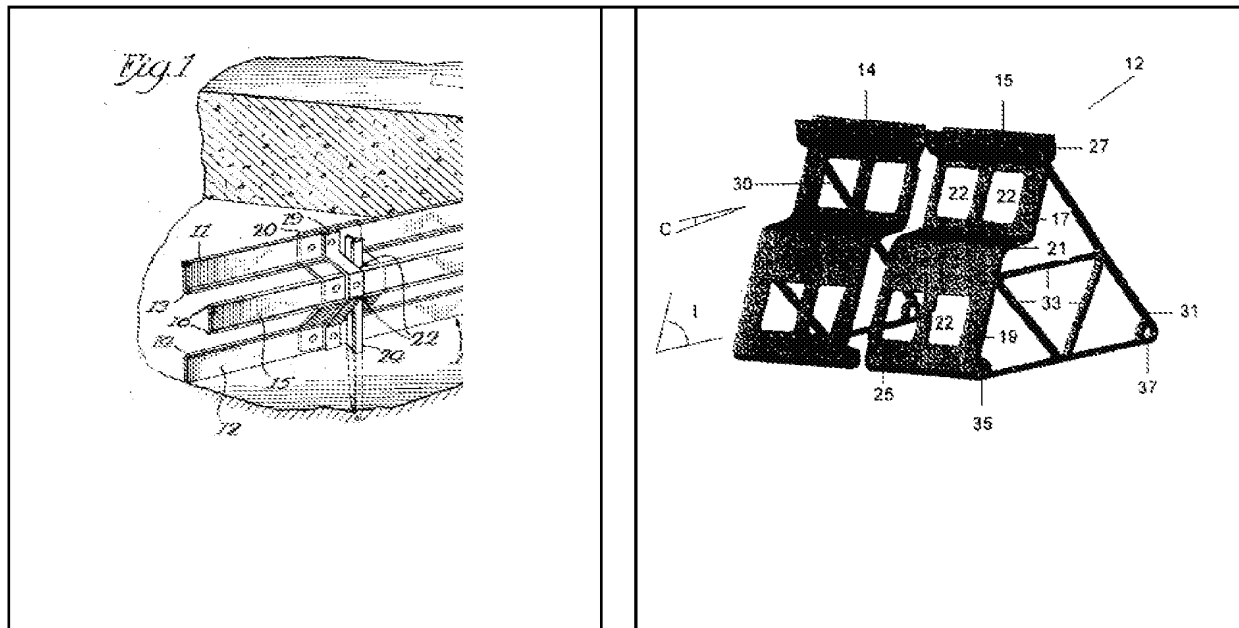


The claimed invention refers to a “crack-locating” device towards alternated sides of the “superficial crack line” as shown in Figs. 5a and 5b. On the other hand the shape of the intended cracks in the slabs is clearly different.

Therefore they are different devices oriented to the solution of different problems.

The basic components of the “crack-locating” device disclosed in *O’Brien* are the strips 11, 15, 17 as clearly shown in Figure 1 that leave “openings” through which the concrete may freely pass (in a vertical direction).

The “trays” of the claimed invention are completely different as can be appreciated from comparing both devices (see below). In particular they do not have openings through which the concrete may freely pass (in a vertical direction).



For at least the foregoing reasons, claim 1 is seen to be clearly allowable over *O'Brien*.

#### The dependent claims

The other claims in this application are each dependent from independent claim 1 discussed above and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

#### **Conclusion**

In view of the foregoing amendments and remarks, Applicant respectfully requests favorable reconsideration and early passage to issue of the present application.

Respectfully Submitted

/Raymond A. DiPerna/  
Raymond A. DiPerna  
c/o Ladas & Parry LLP  
26 West 61<sup>st</sup> Street  
New York, New York 10023  
Reg. No. 44,063  
Tel. No. (212) 708-1950